REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 6 and 11 have been amended. Claims 1, 2, 4-7, 9-12, and 14-30 are pending. Antecedent basis for the amendments is located throughout Applicant's specification, as for example in the description at page 16, line 15 through page 18, line 27. Accordingly, no new matter has been entered.

Rejection of the claims

The Office Action rejected claims 1, 6 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,694,484 ("Mueller").

As amended, claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing a version of a mass-produced printed paper;
> in response to the version, detecting a reference at a first location within the paper, the detected reference being associated with a second location; and
> in response to the detected reference, forming a link within the version between the first location and the second location, the version being displayable on a display device as a likeness of the paper, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the link; and selectable by a user to cause an operation associated with the second location.

Mueller fails to teach the combination of elements in amended claim 1. MPEP § 2143.01 states: "The mere fact that references can be combined or modified does ***not*** render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness..."

In fact, Mueller actually teaches away from the combination of elements in amended claim 1. For example, at col. 6, lines 12-19, Mueller states, "An association tag, for purposes of the present disclosure, is a declarative HTML tag that includes a marker and an index reference. An example of an association tag that is implemented as a comment tag is

<!marker index reference=xxx.xxx style=invisible>. **Because the tag is declarative, it will not be visible when the HTML document is displayed on the screen display device 20**" (emphasis added).

Accordingly, Mueller teaches away from displaying an indication of the association tag, and Mueller therefore contradicts the combination of elements in amended claim 1, which recites: "the first location being: displayable on the display device as part of the likeness; highlighted to indicate the link; and selectable by a user." Thus, in relation to amended claim 1, Mueller fails to teach, or even suggest, any basis for combining in a 35 U.S.C. § 103 rejection.

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to amended claim 1, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a *prima facie* case of obviousness has not been met.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a *prima facie* conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

In relation to claims 6 and 11, Mueller is likewise defective in establishing a *prima facie* case of obviousness.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 6 and 11.

Dependent claims 2, 4, 5 and 16-20 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 7, 9, 10 and 21-25 depend from and further limit claim 6 and therefore are allowable.

Dependent claims 12, 14, 15 and 26-30 depend from and further limit claim 11 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 4-7, 9-12, and 14-30 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 08-1394.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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